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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,935	12/29/2000	Patrick J. Shaughnessy	LOT9-2000-0030 US1	9225

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EXAMINER

SMITH, PETER J

ART UNIT PAPER NUMBER

2176

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/752,935	SHAUGHNESSY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter J Smith	2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7 and 9-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/27/2002</u>   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This action is responsive to communications: amendment filed on 9/7/2004.
2. Claims 1-2, 4-7, and 9-22 are pending in the case. Claims 1, 2, 6, 9, 12, 15, 17, 18, 19, 20, and 21 are independent claims.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1, 18 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1, 18, and 22 recite the limitation "said document" in line 7 of the claim. There is insufficient antecedent basis for this limitation in the claim. Since the method is directed towards "creating documents", the Examiner is confused by the second claim limitation which is directed towards automatically launching a corresponding editor for editing a document.

5. **Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The use of the claim language "A computer program product or computer program element . . ." is not clear as to whether the claim limitations pertain to a computer program

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product or a computer program element. Changing the claim language to “A computer program product . . .” will particularly point out and distinctly claim the subject matter of the invention.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**6. Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 22 is directed towards a “computer program product . . .” for executing method steps. As presently drafted, the claim reads on a computer program per se, which does not constitute statutory subject matter as prescribed under 35 USC §101. Applicant could easily render the claimed invention statutory by amending the preamble to recite “A computer program product stored on a computer readable medium”. The language in the preamble, “for creating document from within a place in collaboration space according” to certain steps does not render the claimed invention statutory because it in effect constitutes intended use. See MPEP §2106:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:  
(A) statements of intended use or field of use,

Therefore, the intended use language does not limit the claim, and cannot be given patentable weight or a cause for the preamble to be statutory.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-2, 4-7, 15-16, 18-19, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Sorge et al. (hereinafter “Sorge”), US 6,613,098 B1 filed 6/15/1999.**

**Regarding independent claims 1 and 18, and 22,** Sorge discloses operating a browser to display a user interface to a place including an editor selection control and from within the browser, upon selection of the editor selection control, automatically launching a corresponding editor for editing a document in col. 3 lines 21-61 and col. 7 lines 33-51. Sorge discloses upon closing the corresponding editor, loading the document to the place in col. 3 lines 9-61 and col. 7 lines 33-51.

**Regarding independent claims 2, 15, and 19,** Sorge discloses a place browser, editor, and data storage for editing and storing a data file in fig. 4 and col. 18 line 15 – col. 19 line 53. Sorge discloses providing at a browser a user interface to a place, said user interface including an upload control in col. 3 lines 21-61 and col. 7 lines 33-51. Sorge discloses executing round trip editing to prepare a data file and loading the data file to the upload control in col. 3 lines 21-61 and col. 7 lines 33-51. Sorge discloses upon loading the data file to the upload control, transferring the data file to a server for conversion and storage as an application enabled object in the place in col. 3 lines 21-61 and col. 7 lines 33-51.

**Regarding dependent claims 4 and 16,** Sorge discloses creating the data file using an editor application independently of the place in collaboration space in col. 3 lines 21-61 and col. 7 lines 33-51. Sorge discloses importing the data file into the place and responsive to user selection at the user interface, loading the data file from the place to the browser in col. 3 lines 21-61 and col. 7 lines 33-51. Sorge discloses launching the editor application and opening the data file in the editor application for further editing at the browser in col. 3 lines 9-18 and col. 7 lines 33-51.

**Regarding dependent claim 5,** Sorge discloses creating the data file using an editor application independently of the place in collaboration space and then importing the data file into the place in col. 3 lines 21-61 and col. 7 lines 33-51. Sorge discloses responsive to user selection at the user interface, loading the data file from the place to the browser, launching the editor application, and opening the data file in the editor application for further editing at the browser in col. 3 lines 9-18 and col. 7 lines 33-51.

**Regarding independent claim 6,** Sorge discloses opening a user interface to the place at a browser, operating the user interface to launch an office application, and using the office application to create a document in col. 3 lines 21-61 and col. 7 lines 33-51. Sorge teaches upon closing the office application, loading the document to the place in col. 3 lines 21-61 and col. 7 lines 33-51.

**Regarding dependent claim 7,** Sorge discloses responsive to user creation or edit of a place document based on the office application, automatically launching the office application to allow the user to edit the document using the office application in col. 3 lines 21-61 and col. 7 lines 33-51.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 9-14, 17, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bookspan et al. (hereinafter "Bookspan"), US 6,629,129 B1 filed 6/16/1999 in view of Sorge et al. (hereinafter "Sorge"), US 6,613,098 B1 filed 6/15/1999.**

**Regarding independent claims 9 and 20,** Bookspan teaches operating a browser at a client to display a user interface to a place, the user interface including a new selector in fig. 2, fig. 4, col. 3 line 30 – col. 4 line 9. Bookspan teaches responsive to a user selection of the new selector, displaying in the user interface a list of available page types, the list including choices corresponding to page editing applications installed on the client in fig. 2, fig. 4, col. 3 line 30 – col. 4 line 9, and col. 9 lines 7-20. Bookspan teaches responsive to user selection of an editing application from the list, displaying a new scene including an upload control and a file icon representing the file being created, and launching the editing application in the foreground displaying the file as a new, empty file in fig. 2, fig. 4, col. 3 line 30 – col. 4 line 9, and col. 9 lines 7-20.

Bookspan does not teach responsive to the user closing the editing application, detecting that the file is no longer being edited and bringing the user interface to the place to the foreground, converting the file to a hypertext file, and displaying the file in the upload control.

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Bookspan does not teach responsive to the user publishing the file, uploading to the server the file along with its equivalent hypertext file and at the server attaching the file to the equivalent hypertext file to the same place document.

Sorge does teach responsive to the user closing the editing application, detecting that the file is no longer being edited and bringing the user interface to the place to the foreground, converting the file to a hypertext file, and displaying the file in the upload control in col. 3 lines 21-61 and col. 7 lines 33-51. Sorge does teach responsive to the user publishing the file, uploading to the server the file along with its equivalent hypertext file and at the server attaching the file to the equivalent hypertext file to the same place document in col. 3 lines 21-61 and col. 7 lines 33-51. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Sorge into Bookspan to have created the claimed invention. It would have been obvious and desirable to have converted the document as a hypertext file and loaded the document and corresponding hypertext file to the place so that other users could have used browser programs to have viewed the document while the document still retained the formatting information of the original document as taught by Sorge in col. 3 lines 21-31.

**Regarding dependent claim 10,** Bookspan does not teach attaching the file and the equivalent hypertext file to the same document. Sorge does teach attaching the file and the equivalent hypertext file to the same document in col. 3 lines 21-61 and col. 7 lines 33-51. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Sorge into Bookspan to have created the claimed invention. It would have been obvious and desirable to have converted the document as a hypertext file and loaded the



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document and corresponding hypertext file to the place so that other users could have used browser programs to have viewed the document while the document still retained the formatting information of the original document as taught by Sorge in col. 3 lines 21-31.

**Regarding dependent claim 11**, Bookspan does not teach generating a list using a hidden ActiveX upload control download to the client from a server, the ActiveX upload control generating the list by listing only those applications for which the upload control successfully obtains a pointer to respective automation server objects. Sorge does teach generating a list using a hidden ActiveX upload control download to the client from a server, the ActiveX upload control generating the list by listing only those applications for which the upload control successfully obtains a pointer to respective automation server objects in col. 7 lines 33-51. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Sorge into Bookspan to have created the claimed invention. It would have been obvious and desirable to have converted the document as a hypertext file and loaded the document and corresponding hypertext file to the place so that other users could have used browser programs to have viewed the document while the document still retained the formatting information of the original document as taught by Sorge in col. 3 lines 21-31.

**Regarding independent claims 12, 17, and 21**, Bookspan teaches operating a browser at a client to display a user interface to a place, the user interface including an edit selector in fig. 2, fig. 4, col. 3 line 30 – col. 4 line 9. Bookspan teaches responsive to user selection of the edit selector, displaying an edit scene including an upload control, the upload control including a document icon representing the document being edited, and launching the editing application in

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the foreground displaying the document in fig. 2, fig. 4, col. 3 line 30 – col. 4 line 9, and col. 9 lines 7-20.

Bookspan does not teach responsive to the user closing the editing application, detecting that the file is no longer being edited and bringing the user interface to the place to the foreground, converting the file to a hypertext file. Bookspan does not teach responsive to the user publishing the document, uploading to the server the document along with its equivalent hypertext file and at the server attaching the file to the equivalent hypertext file to the same place document.

Sorge does teach responsive to the user closing the editing application, detecting that the file is no longer being edited and bringing the user interface to the place to the foreground, converting the file to a hypertext file in col. 3 lines 21-61 and col. 7 lines 33-51. Sorge does teach responsive to the user publishing the document, uploading to the server the document along with its equivalent hypertext file and at the server attaching the file to the equivalent hypertext file to the same place document in col. 3 lines 21-61 and col. 7 lines 33-51. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Sorge into Bookspan to have created the claimed invention. It would have been obvious and desirable to have converted the document as a hypertext file and loaded the document and corresponding hypertext file to the place so that other users could have used browser programs to have viewed the document while the document still retained the formatting information of the original document as taught by Sorge in col. 3 lines 21-31.

**Regarding dependent claim 13,** Bookspan does not teach saving the document to client storage as a web page including the text of the document and formatting information saved as

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tags together with support files or locating in the client storage and uploading the formatting information tags and support files. Sorge does teach saving the document to client storage as a web page including the text of the document and formatting information saved as tags together with support files and locating in the client storage and uploading the formatting information tags and support files in col. 3 lines 21-61 and col. 7 lines 33-51. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Sorge into Bookspan to have created the claimed invention. It would have been obvious and desirable to have converted the document as a hypertext file and loaded the document and corresponding hypertext file to the place so that other users could have used browser programs to have viewed the document while the document still retained the formatting information of the original document as taught by Sorge in col. 3 lines 21-31.

**Regarding dependent claim 14,** Bookspan teaches responsive to the user selecting the edit selector, displaying the edit scene including indicia representing the document and automatically launching an application for editing the document displaying the document in its original form in fig. 2, fig. 4, col. 3 line 30 – col. 4 line 9. Bookspan does not teach responsive to the user making changes to and closing the document, again uploading to the server the document and all support files.

Sorge does teach responsive to the user making changes to and closing the document, again uploading to the server the document and all support files in col. 3 lines 21-61 and col. 7 lines 33-51. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Sorge into Bookspan to have created the claimed invention. It would have been obvious and desirable to have converted the document as a

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hypertext file and loaded the document and corresponding hypertext file to the place so that other users could have used browser programs to have viewed the document while the document still retained the formatting information of the original document as taught by Sorge in col. 3 lines 21-31.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adams, US 5,781,732 patented 7/14/1998 discloses a shared document framework for providing collaborative access to a shared document. Anupam et al., US 5,862,330 patented 1/19/1999 discloses obtaining and exchanging information on the world wide web. Goldberg et al., US 6,205,209 B1 filed 8/25/1998 discloses a network that provides applications collaboration. Butts et al., US 5,754,830 patented 5/19/1998 discloses a web browser emulator for persistent connection to a legacy host system. Muranaga et al., US 5,671,428 patented 9/23/1997 discloses a collaborative document processing system. Sheard et al., US 6,453,356 B1 filed 4/15/1998 discloses a data exchange system.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 571-272-4101. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS  
2/4/2005

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**